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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,660	07/16/2003	Patrick A. Engle	14138.01	9962

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EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,660

Applicant(s)

ENGLE, PATRICK A.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 14-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/5/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the handle formed in two sections of generally equal length in claim 3 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The use of the trademark VELCRO has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

3. Claim 7 is objected to because of the following informalities: The claim uses the trademark, VELCRO. The claim should define the structure using generic terminology. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Morris et al (US 2,554,680).

Regarding claim 1, Morris discloses a storage and transport device (Figures 1-3) having a case body **1 & 2** with a hinge **3** and a latch **5**, a case handle **6**, and an inner portion capable of retaining garden hand tools with interchangeable heads.

As to claims 2 and 3, the examiner notes that the applicant has not positively recited the tools. As such Morris is capable of retaining tools of the nature claimed in claims 2 and 3.

5. Claims 12 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Eatmon (US 6,439,630).

Regarding claim 12, Eatmon discloses a storage and transport device **10** with a case body **12** having an inner portion (as shown, Figure 1); a set of clasps **30 & 32**; and a gardening tool handle **28**. Handle **28** is capable of being used to carry the device.

As to claim 13, clasps **30 & 32** extend outwardly from the edges of the case halves with the gardening tool passing through one clasp and releasably attached to the other clasp (see Figures 1 & 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al (US 2,554,680) in view of Wyss (US 5,738,214).

Morris, as applied to claim 1 above discloses the claimed invention except for the molded plastic inner portion with shaped holding portions.

Wyss discloses a case for tools with a molded plastic inner portion with shaped holding portions (see Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Morris with a molded plastic inner portion having shaped holding portions as taught by Wyss in order to prevent the retained tools from moving during transport.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al (US 2,554,680) in view of Eatmon (US 6,439,630).

Morris, as applied to claim 1 above discloses the claimed invention except for the resilient foam inner portion with shaped holding portions.

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Eatmon discloses a case for tools with a resilient foam inner portion with shaped holding portions (see Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Morris with a resilient foam inner portion having shaped holding portions as taught by Eatmon in order to prevent the retained tools from moving during transport.

8. Claims 6, 8-11, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eatmon (US 6,439,630) in view of Bull (US 2,914,377).

Regarding claim 6, Eatmon, as applied to claim 12 above, discloses the claimed invention except for the porous, oil-coated material.

Bull discloses impregnating (and thereby coating) of a porous material with oil to inhibit rust (see for example Col. 2, lines 17-28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the porous material of Eatmon with oil as taught by Bull in order to inhibit rusting of the stored tools.

As to claim 8, Eatmon discloses c-shaped clasps.

As to claims 9-11, Eatmon-Bull discloses a handle with interchangeable tool heads. Eatmon-Bull does not disclose expressly the means by which the heads are attached.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use any known attachment means because applicant has not disclosed that the specific attachment means provides an advantage, is used for a particular purpose, or solves a stated problem.

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One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with a threaded, pin, or frictional connecting means because they all perform the task of positive engagement of the handle with the tool head.

Therefore, it would have been an obvious matter of design choice to provide the device of Eatmon-Bull with any of the claimed attachment means to obtain the invention as specified in claims 9-11.

As to claims 17-20, the device of Eatmon-Bull, as applied to claim 6 above, discloses the claimed invention.

9. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al (US 2,554,680) in view of Parkhurst (US 1,094,009) and Bull (US 2,914,377).

Regarding claim 6, Morris discloses a storage and transport device (Figures 1-3) having a case body **1 & 2** with a hinge **3** and a latch **5**, a case handle **6**, and an inner portion capable of retaining garden hand tools with interchangeable heads.

Morris lacks a set of clasps with the gardening tool handle attached to the clasps and a porous, oil-coated material in the inner portion.

Parkhurst discloses a storage and transport device with a set of clasps **9** and a tool handle **11** used as a carrying handle (see Figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the handle of Morris with straps to use the tool handle as a handle, as taught by Parkhurst in order to reduce the overall size of the case.

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As to the porous, oil-coated material in the inner portion, Bull discloses impregnating (and thereby coating) of a porous material with oil to inhibit rust (see for example Col. 2, lines 17-28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Morris-Parkhurst with porous, oil-coated material as taught by Bull in order to inhibit rusting of the stored tools.

As to claim 7, Morris-Parkhurst-Bull discloses the claimed invention except for the hook and loop clasps. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the clasps of Morris-Parkhurst-Bull in hook and loop material, since the examiner takes Official Notice of the equivalence of buckles and hook and loop fasteners for their use in the article retention art and the selection of any of these known equivalents to retain the handle would be within the level of ordinary skill in the art.

Allowable Subject Matter

10. Claims 14-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

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Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Colby and LeBlanc disclose the use of item handles as container handles. Jennings discloses a rust inhibiting toolbox. Dory discloses a handle separable into two equal portions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
3 September 2004


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